UNITED STATES PATENT AND TRADEMARK OFFICE

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10/699,703	11/04/2003	Kimitaka Murashita	122.1569	5895

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EXAMINER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
Office Action Summary	10/699,703	MURASHITA ET AL.
	Examiner	Art Unit	
	Jenise E. Jackson	2131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>24 October 2007</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>6-11,14-22,27 and 28</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) <u>27 and 28</u> is/are allowed.

6)☒ Claim(s) <u>6-11 and 14-22</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08)
   Paper No(s)/Mail Date <u>20071119</u>.

4)☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

2.   Claims 6-11, 14-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ortiz

et al(2003/0163710) in view of Ebara(2002/0010862).

3.   As per claim 6, Ortiz et al discloses a biometric data storing unit which stores a plurality

of kinds of biometric data associated with a person[0061, 0100, fig. 8 sheet 8]; a biometric data

acquisition unit which acquires one kind of biometric data[0096]; a person authentication unit

which authenticates said person based on said acquired one kind of biometric data and said

plurality of kinds of biometric data stored in said biometric data storing unit[0114]. Ortiz is

silent on biometric data output unit which selects and outputs a designated kind of biometric data

of the person from said biometric data storing unit to an authentication device including a

dictionary data storing unit storing dictionary data, to authenticate the person by matching the

output designated biometric data with the dictionary data after the person has been authenticated

by said person authentication unit. Ebara discloses biometric data output unit which selects and

outputs a designated kind of biometric data of the person from said biometric data storing unit to

an authentication device including a dictionary data storing unit storing dictionary data, to

authenticate the person by matching the output designated biometric data with the dictionary data

after the person has been authenticated by said person authentication unit[0025-0026, 0028-

0029, 0038]. It would have been obvious to one of ordinary skill in the art at the time of the

invention to include biometric data output unit which selects and outputs a designated kind of

biometric data of the person from said biometric data storing unit to an authentication device

including a dictionary data storing unit storing dictionary data, to authenticate the person by

matching the output designated biometric data with the dictionary data after the person has been

authenticated by said person authentication unit of Ebara with Ortiz, the motivation is that

authentication data obtained in this way are sent to the first enterprise system, where the first

database server apparatus compares the authentication data with its stored template data to

authenticate the user before sending the template data to the second database server thereby

protecting the user's privacy[0013 of Ebara].

4.   As per claim 7, Ortiz et al discloses a biometric data processing unit which edits and

processes at least partially said biometric data selected from said biometric data storing unit,

wherein said edited and processed biometric data is output[0123].

5.   As per claim 8, Ortiz discloses a biometric data converting unit which converts the

format of said biometric data selected from said biometric data storing unit, wherein said format-

converted biometric data is output[0032, 0078-0080].

6.   As per claim 9, Ortiz discloses a corresponding data generating unit which, from said

biometric data selected from said biometric data storing unit, generates corresponding data

having a certain bit length and corresponding to said biometric data, wherein said generated

corresponding data is output from said biometric data output unit[0087-0089].

7.   As per claim 10, Ortiz discloses a corresponding data parameter generating unit which

generates a parameter to be used for generating said corresponding data[0073, 0088].

8.   Same Motivation as claim 1 above. As per claim 11, Ortiz et al discloses a terminal

device[0023] having a biometric data storing unit which stores a plurality of kinds of biometric

data associated with a person[0031-0032, 0034], a biometric data acquiring unit which acquires

one kind biometric data, a second person authentication unit which performs person

authentication by matching the one kind of biometric data acquired by the biometric data

acquiring unit with the plurality of kinds of biometric data stored in the biometric data storing

unit[0023, 0105, 0114]. Ebara discloses and a biometric data transmitting unit which outputs at

least one kind of biometric data when the person has been authenticated by the second person

authentication unit[0028-0029] and an authentication device having a dictionary data storing unit

which stores biometric data as dictionary data to be used for authentication[0038], and a first

person authentication unit which performs first person authentication based on said at least one

kind of biometric data transmitted from said biometric data transmitting unit and said dictionary

data stored in said dictionary data storing unit[0025-0026].

9.   As per claim 14, Ortiz discloses wherein said authentication device comprises a

corresponding data generating unit which, based on said biometric data transmitted from said

biometric data transmitting unit, generates corresponding data having a certain bit length and

corresponding to said biometric data, wherein specific dictionary data stored in said dictionary

data storing unit is located by using said generated corresponding data, and said first person

authentication unit performs said person authentication based on said specific dictionary data and

said transmitted biometric data[0087-0089].

10.   As per claim 15, Ortiz discloses wherein when said person authentication based on said

specific dictionary data cannot be performed, said authentication device performs said person

authentication based on all of said dictionary data stored in said dictionary data storing unit and said transmitted biometric data[0086, 0124].

11. As per claim 16, Ortiz discloses wherein said terminal device includes a first biometric data processing unit which edits and processes at least partially said biometric data selected from said biometric data storing unit[0123], and a first processing data storing unit which stores data that said first biometric data processing unit uses to edit and process said biometric data[0123], and said authentication device includes a second biometric data processing unit which edits and processes said dictionary data at least partially[0105, 0123], and a second processing data storing unit which stores data that said second biometric data processing unit uses to edit and process said dictionary data, and wherein said first person authentication unit performs said person authentication based on said edited and processed biometric data and said edited and processed dictionary data[0105].

12. As per claim 17, Ortiz discloses wherein said authentication device comprises a conversion data storing unit which stores conversion data concerning said biometric data used in said first person authentication unit, and said terminal device comprises a biometric data converting unit which converts the format of said biometric data stored in said biometric data storing unit, and wherein said biometric data converting unit converts the format of said biometric data by using said format data transmitted from said conversion data storing unit, and said format-converted biometric data is transmitted to said authentication device[0078-0080, 0083].

13. As per claim 18, Ortiz discloses a first corresponding data generating unit which generates corresponding data having a certain bit length and corresponding to specific biometric

data selected from along said plurality of biometric data stored in said biometric data storing

unit, and a corresponding data transmitting unit which transmits out said generated first

corresponding data; the authentication device [0122, 0124], a second corresponding data

generating unit which generates corresponding data having a certain bit length and corresponding

to said dictionary data wherein, the first person authentication unit which performs first person

authentication based on said transmitted first corresponding data and said second corresponding

data[0087-0089].

14.   As per claim 19, Ortiz discloses wherein said terminal device includes a biometric data

acquisition unit which acquires biometric data and a second person authentication unit which

performs second person authentication[0023, 0105, 0114], and wherein said second person

authentication is performed using said acquired biometric data and said biometric data stored in

said biometric data storing unit and, when the identity of said person has been authenticated, said

first corresponding data to be used in said first person authentication unit is transmitted to said

authentication device[0105, 0135].

15.   As per claim 20, Ortiz discloses wherein said terminal device includes a first

corresponding data parameter generating unit which generates a corresponding data parameter to

be used for generating said corresponding data, and wherein said generated corresponding data

parameter is not only used in said first corresponding data generating unit, but also transmitted to

said authentication device and used in said second corresponding data generating unit[0073,

0088].

16.   As per claim 21, Ortiz discloses wherein said authentication device includes a second

corresponding data parameter generating unit which generates a corresponding data parameter to

be used for generating said corresponding data, and wherein said generated corresponding data

parameter is not only used in said second corresponding data generating unit, but also

transmitted to said terminal device and used in said first corresponding data generating

unit[0073, 0135].

Claim Rejections - 35 USC § 103

17.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

18.   Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over

Ortiz(2003/0163710) in view of Ebara and further in view of Uchida(2001/0025342).

19.   As per claim 22, Ortiz nor Ebara does not disclose wherein said authentication device

encrypts data that said person has by using said corresponding data used for the authentication of

said person as an encryption key. Uchida discloses wherein the authentication device encrypts

data that the person has by using the corresponding data used for authentication of the person as

an encryption key[0022, 0028]. It would have been obvious of one of ordinary skill in the art at

the time of the invention to include biometric data is encrypted biometric data of Uchida with

Ortiz, because encrypting biometric data is a protective measure that can enhance security,

because even if an unauthorized person steals the biometric data in transit, because the biometric

data is encoded[0067 of Uchida] it is intelligible.

Allowable Subject Matter

20.   Claims 27-28 are allowable for the following features, "the decryption key is used by the

authentication device, the biometric data acquisition device charges a fee to the authentication

device for the use", and "charging a fee to the authentication device according to the number of

times that the biometric data stored into the terminal device by the biometric data acquisition

device is used by the authentication device". Prior art of record fails to disclose charging a fee

for a decryption key, and charging a fee according to the number of times that the biometric data

is stored. In prior art, if a user is enrolled in the system, a user is given a decryption key, there is

no suggestion or disclosure of a charge to use a decryption key, and no suggestion in prior art as

to how many times biometric data is stored. The Applicant is urged to incorporate allowable

subject matter as stated in claims 27-28, in independent claims 6 and 11.

Response to Applicant

21.   The Applicant states that Ortiz does not disclose biometric data is output from the

biometric data storing unit to an authentication device after the person has been authenticated by

the person authentication unit based on acquired one kind of biometric data. The Applicant also

states that Ortiz does not disclose a second person authentication unit performs person

authentication. The Examiner has applied new art Ebara to reject the amended limitations of

claims 6 and 11. Ebara discloses a biometric authentication system(see fig. 1, 0023). Ebara

discloses a first authentication apparatus and a second authentication apparatus(see fig. 1). The

first and second authentication apparatus authenticate the users biometric, Ebara uses iris.

Final Necessitated by Amendment

22.   Applicant's amendment necessitated the new ground(s) of rejection presented in this

Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this

final action.

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Jenise E. Jackson whose telephone number is (571) 272-3791.

The examiner can normally be reached on M-Th (6:00 a.m. - 3:30 p.m.) alternate Friday's.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

November 20, 2007

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